

### **REMARKS**

Claims 1, 48-49, 150, 155-156, and 189-192 are now pending in this application. Claims 1, 48-49, 150, and 155 have been amended; claims 47 and 154 have been canceled; claims 189-192 have been added. In the Final Office Action dated August 11, 2004 ("Office Action"), the Office rejected the previously-pending claims under both 35 U.S.C. §§ 102(b) and 103(a). In light of the RCE submitted herewith, as well as the above amendments and remarks that follow, Applicants submit that this application recites patentable subject matter and is in condition for immediate allowance.

#### **I. Claim Amendments**

Claims 48, 49, and 155 have been amended to correct improper dependencies introduced by the cancellation of claims 47 and 154 made herein. As such, no new matter is added by these amendments and Applicants respectfully request that they be entered without objection.

Claims 1 and 150 have been amended to add the list identifier "(i)" before the recitation of "at least one continuous liquid fatty phase," as well as to add recitations of at least one amphiphilic compound and at least one dyestuff. In particular, support for the recitation of "at least one amphiphilic compound chosen from amphiphilic compounds which are liquid at room temperature and have an HLB value of less than 12" is found in the previously presented (and now canceled) claims 47 and 154, as well as in the original specification in at least page 14, lines 12-15. Support for the recitation of "at least one dyestuff" is found in original claims 1 and 140, as well as in the original

specification in at least page 3, lines 15-16. As such, no new matter is added by these amendments and Applicants respectfully request that they be entered without objection.

Support for new claims 189-190, wherein the at least one polymer is chosen from ethylenediamine/stearyl dimer tallate copolymer, and for new claim 191-192, wherein the at least one polymer is chosen from ethylenediamine/stearyl dimer dilinoleate copolymer, can be found in the originally-filed specification, for example on page 13, lines 13-22, reciting Uniclear® and that Uniclear® “may be mixtures of copolymers derived from monomers of (i) C<sub>36</sub> diacids and (ii) ethylenediamine . . . .” In addition, Exhibit A presents the entries for Uniclear® from the International Cosmetic Ingredient Dictionary and Handbook (“CTFA”), 10th Ed. (2004), which state that a tradename for both species of polymer is known in the art to be Uniclear®.

Applicants note that, in co-pending Application Serial Nos. 09/937,314, 10/012,051, and 10/203,018, the Office requested that those Applicants provide some documentation showing that this species of polyamide polymer (*i.e.*, that known by the trade name Uniclear®) was known at the time these co-pending applications were filed. Accordingly, the Office was provided with a redacted version of confidential proprietary documents from the Assignee company showing that ethylenediamine/stearyl dimer tallate and dilinoleate copolymers were known as Uniclear® prior to the filing date of the applications. See Exhibit B (Redacted Proprietary Documents). The Office also indicated that the same documentation would be required in the present case.

Applicants do not believe, however, that the requested confidential proprietary documents are either necessary or legally required. As discussed above, the specification describes the copolymers known as Uniclear® and necessarily establishes

that this species of at least one heteropolymer was known at the time the application was filed. The information supplied from the CTFA further demonstrates that Uniclear<sup>®</sup> is the trade name for ethylenediamine/stearyl dimer tallate copolymer and ethylenediamine/stearyl dimer dilinoleate copolymer, which establishes that the at least one polyamide polymer claimed was known at the time of filing. However, solely in an effort to advance prosecution of this case, Applicants attach a copy of the redacted confidential proprietary documents in Exhibit B.

Based on this supporting evidence, the original specification would convey to one of ordinary skill in the art that the Applicants had possession of the recited polymers at the time this invention was filed. Therefore, no new matter is added by these amendments and Applicants respectfully request that they be entered without objection.

## **II. Replacement Abstract**

Applicants have deleted the previous abstract and provided herewith a Replacement Abstract, in an effort to describe more accurately the now pending claims. Applicants respectfully submit that the Replacement Abstract contains no new matter and ask that it be entered without objection.

### III. Rejection under 35 U.S.C. § 102

The Office rejected claims 1 and 150 under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,998,570 to Pavlin et al. ("Pavlin").<sup>1</sup> According to the Office, Pavlin teaches "the same polymer claimed," and "[t]he language recited in the claims with respect to structured composition, in the form of non-migrating, wax free solid[,] is inherent." Office Action at page 2. Although Applicants disagree with the rejection on its merits, the amendments to claims 1 and 150 obviate this rejection.

To establish anticipation under 35 U.S.C. § 102(b), a single reference must either expressly or inherently teach each and every element of the claim. See MPEP § 2131. Amended claims 1 and 150 recite, among other things, "at least one amphiphilic compound chosen from amphiphilic compounds which are liquid at room temperature and have an HLB value of less than 12." The Office admits that "[Pavlin] does not teach [the] amphi[phi]lic compound[s] claimed . . . ." Office Action at page 3. As each of the currently pending claims recite amphiphilic compounds that are not taught by Pavlin, the reference cannot anticipate and Applicants request that the rejection with withdrawn.

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<sup>1</sup> The Office Action bases the rejection on U.S. Patent No. "5,998,657 ('657)." Applicants note that U.S. Patent No. 5,998,657, entitled "Process for the generation of  $\alpha$ ,  $\beta$ -unsaturated carboxylic acids and esters using niobium catalyst," does not appear to be related art. However, both U.S. Patent No. 5,998,570 to Pavlin et al. and U.S. Patent No. 5,783,657 to Pavlin et al. are of record in the instant case. As U.S. Patent No. 5,998,570 has already been cited by the Office in this case, and as 5,783,657 (not previously cited by the Office) was not listed on the Notice of References Cited, Applicants presume the Office intended to reject the instant claims over U.S. Patent No. 5,998,570 to Pavlin et al. If this was not the Office's intention, Applicants respectfully request the Office expressly clarify the intended reference on the record.

#### IV. Rejection under 35 U.S.C. §103

The Office rejected claims 1, 47-49, 150, and 154-156 under 35 U.S.C. § 103(a) as allegedly obvious over Pavlin and U.S. Patent No. 6,066,328 to Ribier ("Ribier"). According to the Office, while Pavlin does not teach the at least one amphiphilic compound, Ribier "teaches amphi[phi]lic compounds in cosmetic compositions." Office Action at page 3. From this, the Office concludes that "[o]ne of ordinary skill in the art would be motivated to combine the ingredients with the reasonable expectation of success, since the amphi[phi]lic compounds when added to the composition enhance[ ] the penetration of cosmetic compositions into the skin." *Id.* Applicants respectfully disagree with the Office and traverse this rejection.

In order to prove a *prima facie* case of obviousness, the Office must show that the cited references provide to one of ordinary skill in the art some suggestion or motivation to combine or modify their teachings in an effort to achieve all of the limitations of the claimed invention, with a reasonable expectation of success. See MPEP § 2143. The Office has not fulfilled at least two of these requirements, as Ribier does not teach or suggest at least one amphiphilic compound chosen from amphiphilic compounds which are liquid at room temperature and have an HLB value of less than 12, and the Office has established no motivation to combine Pavlin and Ribier.

Ribier teaches "an emulsion of oil-in-water type formed of oily globules." Page 1, abstract. These "oily globules" are formed from "at least one lipophilic compound . . . coated with a monolamellar or oligolamellar layer obtained from at least one lipophilic surface-active agent, from at least one hydrophilic surface-active agent and from at least one ionic amphiphilic lipid . . . ." *Id.* The Office has not established that the oily

globule of Ribier is at least one amphiphilic compound chosen from amphiphilic compounds which are liquid at room temperature and have an HLB value of less than 12. Likewise, the Office has not established that the ionic amphiphilic liquid would have an HLB value of less than 12. In fact, although Ribier expressly describes that the lipophilic surface-active agent preferably has an HLB value between 2 and 5, and that the hydrophilic surface-active agent preferably has an HLB value between 8 and 12, the reference is noticeably silent regarding the HLB of either the oily globule as a whole or the ionic amphiphilic liquid. See col. 3, lines 7-9 and 33-34. As the reference does not teach or suggest all of the claim elements, no *prima facie* case of obviousness has been established and Applicants respectfully request withdrawal of the rejection.

Moreover, even assuming that all of the claim elements were taught or suggested by Pavlin and Ribier, the Office has failed to establish any suggestion or motivation to combine the two references. Pavlin discloses "materials which can be combined with pure hydrocarbon to afford a transparent material which has gel-like character." Col. 2, lines 26-28 (emphasis added). The oily globules having a mean diameter of less than 500 nanometers, as disclosed by Ribier, however, would not maintain their character in a pure hydrocarbon. To the contrary, Ribier teaches that the oily globules are mixed as the oil phase in an oil-in-water emulsion. See page 1, abstract. As one of ordinary skill in the art would readily recognize, the oily globules would cease to exist as such in the pure hydrocarbon solution of Pavlin.

The Office has failed to explain why one of ordinary skill in the art would have been motivated to combine the oily globules of Ribier with Pavlin, when doing so would destroy the intention of Ribier's invention, which is to maintain the small size of the oily

globules. Ribier expressly states that “[o]n account of the small size of the oily globules, their penetration into the intercorneocytic spaces, which are of comparable size, is greatly facilitated.” Col. 2, lines 60-63. Even the Office recognizes the importance of penetrability and the oily globules of Ribier, stating that the alleged motivation to combine Pavlin and Ribier stems from the notion that a skilled artisan would have a reasonable expectation of success “since the amphi[phi]lic compounds when added to the composition[ ] enhances the penetration of cosmetic compositions into the skin.” Office Action at page 3. As discussed above, the penetrability of the oily globules would be destroyed if added to the composition of Pavlin, and thus there is no motivation to combine the two references. “A proposed modification [is] inappropriate for an obviousness inquiry when the modification render[s] the prior art reference inoperable for its intended purpose.” *In re Fritch*, 972 F.2d 1260, 1265 n.12 (Fed. Cir. 1992).

As Ribier nowhere teaches or suggests at least one amphiphilic compound chosen from amphiphilic compounds which are liquid at room temperature and have an HLB value of less than 12, and as the Office has also failed to establish any motivation to combine Pavlin and Ribier, Applicants respectfully request the reconsideration and the withdrawal of this rejection.

## **V. Co-Pending Applications**

In the Amendment filed on May 19, 2004, in this case, Applicants noted in Table 2 information regarding 36 co-pending applications, including the present application, and submitted copies of the pending claims as of that date for every case identified in Table 2. In the following continuation of Table 2, Applicants have noted five additional

applications that have been filed and enclose herewith in Exhibit C a copy of the co-pending claims for those cases. Furthermore, Applicants also provide in Exhibit C copies of the currently pending claims from the following co-pending applications whose claims have been amended since May 19, 2004: 09/618,066; 09/685,578; 09/733,896; 09/733,898; 09/733,899; 09/733,900; 09/937,314; 10/012,029; 10/012,051; 10/012,052; 10/046,568; 10/047,987; 10/182,830; 10/198,931; 10/203,018; 10/203,374; and 10/787,440. Applicants submit these claims for the Office's convenience in evaluating any potential issues regarding statutory or obviousness-type double patenting.

**Table 2 (continued) — Information for Co-Pending Applications**

Attorney Docket No.	U.S. Patent Application No.	U.S. Filing Date	Inventor(s)	Title	Assignment Information (Reel, Frame, Date)	Publication Status
05725.0808-02000	10/918,579	August 16, 2004	Carlos O. PINZON, Paul THAU, and Isabelle BARA	COMPOSITIONS CONTAINING HETEROPOLYMERS AND OIL-SOLUBLE ESTERS AND METHODS OF USING SAME	Reel 011654, Frame 0869, on April 2, 2001	Not yet published
05725.0932-01000	10/933,431	November 22, 2004	Véronique FERRARI	A TRANSFER-FREE COMPOSITION STRUCTURED IN RIGID FORM BY A POLYMER	Reel 012476, Frame 0507, on January 17, 2002	Not yet published
05725.1003-01000	10/993,430	November 22, 2004	Nathalie COLLIN	COSMETIC COMPOSITION COMPRISING A POLYMER BLEND	Reel 013142, Frame 0645, on August 1, 2002	Not yet published
05725.1004-01000	10/990,475	November 18, 2004	Nathalie COLLIN	USE OF A POLYMER FOR OBTAINING AN EXPRESS MAKE-UP OF KERATIN MATERIALS	Reel 012847, Frame 0285, on April 30, 2002	Not yet published



Attorney Docket No.	U.S. Patent Application No.	U.S. Filing Date	Inventor(s)	Title	Assignment Information (Reel, Frame, Date)	Publication Status
05725.1378-00000	11/019,382	December 23, 2004	Wei YU and Véronique FERRARI	COSMETIC COMPOSITION COMPRISING TWO DIFFERENT HETERO POLYMERS AND METHOD OF USING SAME	Assignment Not Yet Filed	Not yet published

## VI. Information Disclosure Statement

Applicants appreciate the Office's return of the signed Form PTO-1449 from the Information Disclosure Statement submitted on May 19, 2004. Applicants note that several of the documents listed on this Form were crossed through, rather than initialed. Applicants believe that those documents were properly listed and respectfully request that the Office consider the documents and indicate that the documents were considered. For the Office's convenience, Applicants submit herewith a new Information Disclosure Statement and IDS Form PTO/SB/08, including a listing of the documents crossed through by the Office. If the Office disagrees, Applicants would greatly appreciate the citation of a regulation or PTO rule establishing that Applicants' submission was improper.

## VII. Conclusion

In view of the foregoing amendments and remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims. In the event that the Office does not believe this application is in immediate

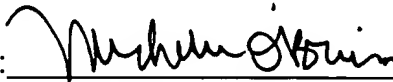
condition for allowance, Applicants respectfully request that the Office contact the undersigned at the telephone number listed below to discuss an appropriate resolution.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: February 11, 2005

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Enclosures

Exhibit A: Entries for "ethylenediamine/stearyl dimer dilinoleate copolymer,"  
"ethylenediamine/stearyl dimer tallate copolymer," and "Uniclear"  
CTFA 10th Ed. (2004), pages 657-658 and 3583

Exhibit B: Redacted Proprietary Documents

Exhibit C: Claims from Co-Pending Cases

Replacement Abstract